REMARKS

Claims 1-3 and 5 remain pending in the application. Independent Claim 25 has been canceled. Claim 1 is the only remaining independent claim.

Applicant thanks the Examiner for the withdrawal of the previous rejection under 35 USC 112, second paragraph, and the rejections under 35 USC 102(e) based on US Patent 6,446,130 (Grapes) and under 35 USC 103(a) based on Grapes and US Patent 6,385,595 (Kolling et al.).

Section 102(e) and 103(a) rejections

Claim 25 was rejected under 35 USC 102(e) based on *newly-cited* US Patent 5,794,217 (Allen). The cancellation of Claim 25 renders this rejection moot.

Claims 1-3 and 5 were rejected under 35 USC 103(a) as being unpatentable over *newly-cited* Allen in view of previously-cited US Patent 6,385,595 (Kolling et al.). In view of the following remarks, this rejection is respectfully traversed and reconsideration is requested.

Independent Claim 1 is directed to a method for preparing graphical content associated with corresponding digital audio content, including receiving the graphical content associated with the corresponding audio digital content from a digital database and preparing the graphical content for packaging with a compact disk containing the corresponding digital audio content by implementing at least one format conversion. The *format conversion includes utilizing a first software program to manipulate the digital graphical content, creating postscript files corresponding to the digital graphical content, manipulating the postscript files corresponding to the graphical content utilizing a second software program, creating PDF files corresponding to the digital graphical content and printing the PDF files.*

The Action acknowledges that Allen does not teach or suggest "a software program for manipulating and creating both postscript and PDF files". However, the action takes the position that it would have been an "obvious modification of the system disclosed by Allen" to incorporate "off-the-shelf software packages", for "manipulating, converting and creating both postscript and PDF files" (as allegedly taught in Kolling).

It is respectfully submitted that any permissible combination of the teachings of Allen and Kolling fails to teach or suggest the method recited in independent Claim 1.

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Allen, as acknowledged in the Office Action, does *not teach or suggest* a method for preparing graphical content including receiving the graphical content associated with the corresponding audio digital content from a digital database and preparing the graphical content for packaging with a compact disk containing the corresponding digital audio content by implementing at least one format conversion – in which the format conversion includes (1) utilizing a first software program to manipulate the digital graphical content, (2) creating postscript files corresponding to the digital graphical content, (3) manipulating the postscript files corresponding to the graphical content utilizing a second software program, and (4) creating PDF files corresponding to the digital graphical content and printing the PDF files.

Applicant respectfully traverses the alleged "obvious" combination of the teachings of Allen and Kolling in the manner suggested in the Action. There would be no teaching or suggestion, to one of ordinary skill in the art, to combine the teachings of Allen and Kolling to modify Allen "by employing off-the-shelf software packages taught by Kolling for their ubiquitous use in desktop publishing and printable materials and for their support in creating, editing and converting file formats". One of ordinary skill in the art would have absolutely no motivation to combine the teachings of Allen and Kolling in the manner proposed in the Action.

Rather, Allen expressly describes at col. 8, lines 23-31, that the "content capture device 9 initiates the graphic compression process 8 whereby the graphic data file held at the spooling storage 4 is compressed...compressed graphic files are transferred to the postresampling/ compression storage 16", and, as described at col. 11, lines 51-56, the "system processor 92 directs the text and graphics portion of the item data file to the graphics decompressor process 94 where it is expanded to its original content size...[t]his process could be accomplished using the JPEG decompression algorithm...decompressed information is sent to the printing device 110 for reproduction".
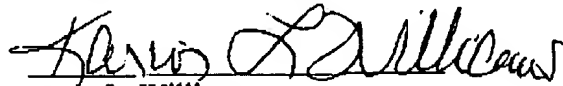
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One of ordinary skill in the art simply would not turn to the alleged teachings of Kolling, directed to an "electronic statement presentation system", to somehow modify (or combine an alleged element thereof with) the teachings of Allen, to achieve the method for preparing graphical content associated with corresponding digital audio content recited in Applicant's independent Claim 1, when Allen very specifically utilizes a graphic compression/decompression process.

For at least the foregoing reason, Applicant respectfully submits that independent Claim 1 is patentable over any permissible combination of the teachings of Allen and Kolling and reconsideration is requested.

Dependent Claims 2, 3 and 5 are believed to be clearly patentable for all of the reasons indicated above with respect to Claim 1, from which they depend, and even further distinguish over the cited references by reciting additional distinguishing limitations.

It is respectfully submitted that in regard to the above remarks that the pending application is patentable over the art of record and reconsideration is accordingly requested. Should the Examiner be of the view that an interview would expedite consideration of this Amendment or of the application at large, request is kindly made that the Examiner telephone Applicant's undersigned attorney at (908) 518-7700 in order that any outstanding issues may be resolved.

Respectfully submitted,

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